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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/697,083	10/31/2003	Wesley Scott Ashton	ASHTON0009	9725

7590
Wesley Scott Ashton
8549 Black Foot Court
Lorton, VA 22079

03/10/2010

EXAMINER

REESE, DAVID C

ART UNIT	PAPER NUMBER
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3677

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/697,083	Applicant(s) ASHTON, WESLEY SCOTT	
	Examiner DAVID REESE	Art Unit 3677	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 October 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-27, 31, 36-39 and 42-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-27, 31, 36-39, and 42-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The indicated allowability of claims 38-39, 42-45, and 48-49 is withdrawn in view of the newly discovered reference(s). Rejections based on the newly cited reference(s) follow.

THIS NON-FINAL ACTION IS RESPONSIVE TO THE AMENDMENT FILED 10/8/2009.

- Claims 1-20, 28-30, 32-35, and 40-41 are canceled.
- Claims 21, 31, 36-37 were amended.
- Claims 21-27, 31, 36-39, and 42-48 are pending.

Claim Rejections - 35 USC § 103

[1] The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

[2] Claims 21-27, 36, 44, and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaping, Jr., US-6,026,659, in view of Kasdin, US-3,503,127.

Although the invention is not identically disclosed or described as set forth 35 U.S.C. 102, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a designer having ordinary skill in the art to which said subject matter pertains, the invention is not patentable.

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As for Claims 21, 36, and 44, Kaping, Jr. teaches of a method comprising the steps of providing a mouth and tongue stud, wherein the stud further comprises a bar (12) having ends, a first end member (14) attached to one end of the bar and a second end member (16) attached to an other end of the bar, and the first end member (14) removably attaches to the one end of the bar; mounting the bar (12) of the stud in a fistula formed in a wearer's tongue or in the wearer's lip.

The difference between the claim and Kaping, Jr. is that Kaping, Jr. does not expressly disclose of the bar possessing a means for dispensing a substance formed in a portion of the stud, wherein the means for dispensing a substances contains the substances and dispensing the substance into the wearer's mouth, wherein the substances is dispensed into the wearer's mouth solely by dissolving the substance over time in the wearer's saliva so that he dissolved substances is free to flow from the means for dispensing into the wearer's mouth. Kasdin discloses a method for dispensing a substance such as a pill or other mixture of a sweet smelling solution, and the like, in the area of the mouth of a wearer. In addition, Kasdin further teaches that the means (15,20) for dispensing a substance (21) formed in a portion of the applicator, wherein the means (15,20) for dispensing a substances contains the substances (21) and dispensing the substance (21) into the wearer's mouth, wherein the substances (21) is dispensed into the wearer's mouth solely by dissolving the substance (21) over time in the wearer's saliva so that he dissolved substances is free to flow from the means (15,20) for dispensing into the wearer's mouth (see summary of the invention, "...The cap is aperture so that saliva can seep through the cap to dissolve the pill slowly"). In addition, Kasdin teaches that this substance has a solid form and a tablet form (claim 44).

It would have been obvious to one of ordinary skill in the art, having the disclosures of Kaping, Jr. and Kasdin before him at the time the invention was made, to modify the mouth and tongue stud of Kaping, Jr. to include means for dispensing a substance formed in a portion of the stud, wherein the means for dispensing a substances contains the substances and dispensing the substance into the wearer's mouth, wherein the substances is dispensed into the wearer's mouth solely by dissolving the substance over time in the wearer's saliva so that he dissolved substances is free to flow from the means for dispensing into the wearer's mouth, as in Kasdin. One would have been motivated to make such a combination because such a configuration of the mouth and tongue stud will provide to the user a convenient and reliable means to deliver active substances, such as a breath freshener to the user in uniform dosage over an extended period of time (see summary of the invention), as taught by Kasdin. Moreover, it would have been obvious to a person of ordinary skill in the art to have modified the mouth and tongue stud of Kasdin, as a person with ordinary skill has good reason to pursue the known options within his or her technical grasp. In turn, because the means for dispensing a substance into a mouth as claimed has the properties predicted by the prior art of Kasdin, it would have been obvious to make the alteration in order to gain the commonly understood benefits and applications of such an adaptation and/or modification.

Re: Claim 46, Kaping, Jr., teaches wherein the bar (12) is a solid bar that is without an internal cavity, and the means for dispensing a substance is formed in the second end member (after the modification in view of Kasdin, it would be obvious to palace the substance in any part of said mouth and tongue stud).

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[3] Claims 38 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaping, Jr., US-6,026,659, in view of Sipos, US-3,600,807.

Although the invention is not identically disclosed or described as set forth 35 U.S.C. 102, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a designer having ordinary skill in the art to which said subject matter pertains, the invention is not patentable.

As for Claim 38, Kaping, Jr. teaches of a method comprising the steps of providing a mouth and tongue stud, wherein the stud further comprises a bar (12) having ends, a first end member (14) attached to one end of the bar and a second end member (16) attached to an other end of the bar, and the first end member (14) removably attaches to the one end of the bar; mounting the bar (12) of the stud in a fistula formed in a wearer's tongue or in the wearer's lip so that the first end member (14) and the second end member (16) hold the stud in the fistula.

The difference between the claim and Kaping, Jr. is that Kaping, Jr. does not expressly disclose of the bar possessing a means for dispensing a substance formed in a portion of the stud, wherein the means for dispensing a substances contains the substances and dispensing the substance into the wearer's mouth, and wherein an insert is disposed in the means for dispensing a substance and dispensing the substance into the wearer's mouth, wherein the substances is dispensed by diffusing the substance over time in the wearer's saliva. Sipos discloses a method for dispensing a substance in the area of the mouth of a wearer (see summary of the invention). In addition, Sipos further teaches of dispensing the substance into the wearer's mouth, wherein an insert (18) is disposed in the means for dispensing a substance and wherein the substances is

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dispensed by diffusing the substance over time in the wearer's saliva (see summary of the invention). It would have been obvious to one of ordinary skill in the art, having the disclosures of Kaping, Jr. and Sipos before him at the time the invention was made, to modify the mouth and tongue stud of Kaping, Jr. to include means for dispensing a substance formed in a portion of the stud, wherein the means for dispensing a substances contains the substances and dispensing the substance into the wearer's mouth, and wherein an insert is disposed in the means for dispensing a substance and dispensing the substance into the wearer's mouth, wherein the substances is dispensed by diffusing the substance over time in the wearer's saliva, as in Kasdin. One would have been motivated to make such a combination because such a configuration of the mouth and tongue stud will provide to the user a convenient and reliable means to deliver active substances, such as a breath freshener to the user in uniform dosage over an extended period of time (see summary of the invention), as taught by Sipos. Moreover, it would have been obvious to a person of ordinary skill in the art to have modified the mouth and tongue stud of Sipos, as a person with ordinary skill has good reason to pursue the known options within his or her technical grasp. In turn, because the means for dispensing a substance into a mouth as claimed has the properties predicted by the prior art of Sipos, it would have been obvious to make the alteration in order to gain the commonly understood benefits and applications of such an adaptation and/or modification.

Re: Claims 48, wherein the substance comprises a liquid (see summary of the invention, as well as col. 2, beginning with line 61).

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[4] Claims 31 and 37, 39, 42-43, 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaping, Jr., US-6,026,659, in view of Cox, US-4,959,052.

Although the invention is not identically disclosed or described as set forth 35 U.S.C. 102, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a designer having ordinary skill in the art to which said subject matter pertains, the invention is not patentable.

As for Claims 31, 37, 39, and 45, Kaping, Jr. teaches of a method comprising the steps of providing a mouth and tongue stud, wherein the stud further comprises a bar (12) having ends, a first end member (14) attached to one end of the bar and a second end member (16) attached to an other end of the bar, and the first end member (14) removably attaches to the one end of the bar; mounting the bar (12) of the stud in a fistula formed in a wearer's tongue or in the wearer's lip.

The difference between the claim and Kaping, Jr. is that Kaping, Jr. does not expressly disclose of the bar possessing a means for dispensing a substance formed in a portion of the stud, wherein the means for dispensing a substances contains the substances and dispensing the substance into the wearer's mouth, wherein the substances is dispensed into the wearer's mouth solely by dissolving the substance over time in the wearer's saliva so that he dissolved substances is free to flow from the means for dispensing into the wearer's mouth. Cox discloses a method for dispensing a substance such as medicaments, antibiotics, nutrients, oral care agents, and the like, in the area of the mouth of a wearer. In addition, Cox further teaches that the means (4, 5) for dispensing a substance (12) formed in a portion of the applicator, wherein the means

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(4,5) for dispensing a substances contains the substances (12) and dispensing the substance (12) into the wearer's mouth, wherein the substances (12) is dispensed into the wearer's mouth solely by dissolving the substance (12) over time in the wearer's saliva so that he dissolved substances is free to flow from the means (4,5) for dispensing into the wearer's mouth (see col. 2, line 44, "...dispense active substances...by means of the number, size or shape of the passage openings, the flow of saliva available for the dissolution and emission of the active substances..."). In addition, Cox also teaches of an insert, such as 3 in fig. 3 (claim 37) and of the substance (12) being in the form of solid (crystallized form) and tablet form (claims 42-45).

It would have been obvious to one of ordinary skill in the art, having the disclosures of Kaping, Jr. and Cox before him at the time the invention was made, to modify the mouth and tongue stud of Kaping, Jr. to include means for dispensing a substance formed in a portion of the stud, wherein the means for dispensing a substances contains the substances and dispensing the substance into the wearer's mouth, wherein the substances is dispensed into the wearer's mouth solely by dissolving the substance over time in the wearer's saliva so that he dissolved substances is free to flow from the means for dispensing into the wearer's mouth, as in Cox. One would have been motivated to make such a combination because such a configuration of the mouth and tongue stud will provide to the user a convenient and reliable means to deliver active substances such as medication to the user in uniform dosage over an extended period of time (see background of the invention), as taught by Cox. Moreover, it would have been obvious to a person of ordinary skill in the art to have modified the mouth and tongue stud of Kaping, Jr., as a person with ordinary skill has good reason to pursue the known options within his or her technical grasp. In turn, because the means for dispensing a substance into a mouth as claimed

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has the properties predicted by the prior art of Cox, it would have been obvious to make the alteration in order to gain the commonly understood benefits and applications of such an adaptation and/or modification.

Re: Claims 47, Kaping, Jr., teaches wherein the bar (12) is a solid bar that is without an internal cavity, and the means for dispensing a substance is formed in the second end member (after the modification in view of Cox, it would be obvious to place the substance in any part of said mouth and tongue stud).

[5] Claim 49 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kaping, Jr., US-6,026,659, in view of Cox, US-4,959,05, and in further in view of Kasdin, US-3,503,127.

Although the invention is not identically disclosed or described as set forth 35 U.S.C. 102, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a designer having ordinary skill in the art to which said subject matter pertains, the invention is not patentable.

As for Claim 49, Kaping, Jr. in view of Cox teach that of the above claims. The difference between the claim and Kaping, Jr., in view of Cox is that Kaping, Jr., in view of Cox does not expressly state of the substance comprising a liquid. Kasdin teaches of a method for dispensing a substance such as a pill in the area of the mouth of a wearer. In addition, Kasdin further teaches that instead of the substance being a pill, it can also be a mixture of a sweet smelling solution (see summary of the invention, as well as from col. 2, beginning with line 61). It would have been obvious to one of ordinary skill in the art, having the disclosures of Kaping,

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Jr., in view of Cox and Kasdin before him at the time the invention was made, to modify the means for dispensing a substance to have the substance include that of a liquid, as in Kasdin.

One would have been motivated to make such a combination for more efficient dissolution and uptake of the medicine to the user.

Response to Arguments

[6] Applicant's amendment, remarks, and affidavit filed 10/8/2009 regarding rejections under 35 U.S.C. 103 have been fully considered. However, upon further consideration of the amended claims, a new ground(s) of rejection as set forth above. Consequently, all arguments are considered moot to said new grounds of rejection. Please also note the additional notice of reference cited.

Conclusion

[7] **THIS ACTION IS NON-FINAL**

[8] Any inquiry concerning this communication or earlier communications from the examiner should be directed to David C. Reese whose telephone number is (571) 272-7082. The examiner can normally be reached on 7:30 am-6:00 pm Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Victor Batson can be reached at (571) 272-6987. The fax number for the organization where this application or proceeding is assigned is the following: (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/DAVID REESE/

Examiner, Art Unit 3677

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